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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number Q64615 | |
| Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450 | Application Number | Filed | |
| | 09/875,890 | June 08, 2001 | |
| | First Named Inventor | | |
| | Frank DIEBOLT | | |
| | Art Unit | Examiner | |
| | 2642 | Rasha S. AL AUBAIDI | |
| <p style="text-align: center;">WASHINGTON OFFICE 23373 CUSTOMER NUMBER</p> | | | |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. However, applicant will cancel claims 9 and 10 if that will result in allowance of the application. Applicant therefore invites a review decision of the format described in "Finding 2" in the OG Notice of July 12, 2005.</p> <p>This request is being filed with a notice of appeal</p> <p>The review is requested for the reasons(s) stated on the attached sheet(s).</p> <p>Note: No more than five (5) pages may be provided.</p> <p><input checked="" type="checkbox"/> I am an attorney or agent of record.</p> <p>Registration number <u>28,703</u></p> <p style="text-align: right;"><u>/DJCushing/</u> Signature</p> <p style="text-align: right;"><u>David J. Cushing</u> Typed or printed name</p> <p style="text-align: right;"><u>(202) 293-7060</u> Telephone number</p> <p style="text-align: right;"><u>April 14, 2006</u> Date</p> | | | |

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q64615

Frank DIEBOLT, et al.

Appln. No.: 09/875,890

Group Art Unit: 2642

Confirmation No.: 7222

Examiner: Rasha S. AL AUBAIDI

Filed: June 08, 2001

For: PROCESS COMMAND TRANSFER FROM A WIRELESS TELECOMMUNICATIONS
DEVICE TOWARD A NEARBY TERMINAL

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the new Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated December 14, 2005, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

The application includes claims 1-10. Applicant would like to cancel claims 9 and 10 for purposes of appeal in the present case, but according to the procedures set forth in the OG Notice of July 12, 2005, applicant cannot file an amendment canceling claims 9 and 10 and still be entitled to the pre-appeal brief review. Accordingly, applicant requests a decision in the format described as "Finding 2" in the OG Notice of July 12, 2005, i.e., including a proposed amendment suggesting the cancellation of claims 9 and 10.

Applicant turns now to the rejections at issue:

The invention is directed to a method and device whereby a mobile terminal user can direct a command, e.g., a print command, to a network device located nearby. A goal of the invention is to relieve the user of the burden of scrolling through a long list of network devices to figure out which one is convenient. Accordingly, according to the invention, the user sends the command from the mobile terminal to the base station to which the mobile is currently connected, the base station forwards the command to a computer on the network, and the computer figures out which network device is close to the user. In a cellular telephone network

such as GSM, GPRS, UMTS, the cells are larger and cover significant geographical areas. In an internal cellular network (e.g., DECT, Bluetooth), the cells are much smaller. In either case, the base station to which the command is sent from the mobile terminal supplies at least part of the command to a computer which determines which cell the user is in and then forwards the command to a network device in that cell, since that will be near to the user.

A characteristic feature of the invention is that the user does not specify which network device is close to the mobile user but instead the mobile simply sends the command to the network and a computer connected to the network figures out which network device should be used to process the command sent from the mobile.

Claims 1-8 are rejected under 35 USC 103(a) as unpatentable over Wang et al (USP 6,230,024) in view of Mohebbi et al (USP 6,925,303).

Wang et al discloses a technique for converting a call from voice to fax. It is directed to an entirely different problem than the present invention. Wang et al shows (Fig. 1) a mobile terminal 104 in wireless communication with a base station schematically illustrated as a tower), which is connected through a base station controller 112 and mobile switching center 120 to a public switched telephone network (PSTN) 128. A fax machine 124 is connected to the PSTN. The Wang et al specification does not describe anything about the physical or geographic location of the fax machine 124. This is not relevant in Wang et al. It is simply the destination of a fax being sent (or the source of a fax being received) by the mobile terminal 104.

Turning to the language of claim 1, the claim preamble requires that there be a cellular telecommunications system having at least two cells, whereas only one is shown in Wang et al. The preamble further requires at least one terminal device located in each cell. The only terminal device shown in Wang et al is the fax machine 124, but there is no discussion anywhere in Wang et al of this being in the same cell as the mobile 104. The claim preamble further requires that the terminal device be coupled to a network, and that the network is coupled to the cellular communications system through a computer. The examiner equates the claimed computer with the CPU 610 (Fig. 6) within the base station (presumably 112 in Fig. 1).

The claim then recites the following steps.

1. Generating a process command on the wireless telecommunications device.
2. Transmitting a radio signal that communicates the process command from the wireless telecommunications device to one of the base stations.
3. Forwarding at least part of the process command from the base station to the computer.
4. Applying rules at the computer to select a terminal device which, at the time the process command was generated by the mobile, was resident in the cell controlled by the base station that received the radio signal.
5. Performing at least part of said process command on the selected terminal device.

During the course of a fax communication, it will be assumed that the mobile terminal 104 in Wang et al performs steps 1 and 2.

Regarding step 3, it is a bit odd to consider the command as being forwarded *from* the base station *to* the computer, since the computer 610 is within the base station.

Regarding step 4, it is not clear where any rules are applied in Wang et al, but what is clear is that the destination fax machine 124 will be chosen by the fax number specified by the mobile terminal. This choice will have nothing whatsoever to do with whether or not a fax machine is within the cell controlled by the base station to which the mobile terminal is presently connected. In fact, given the size of a typical cell, it would be unacceptable for the mobile terminal 104 to only be able to send faxes to fax machines within the same cell.

Regarding step 5, the fax will be received by the fax machine 124, and this fax machine 124 will have been “selected” according to the number specified by the mobile terminal 104, but it will not be a fax machine selected from amongst plural fax machines each resident in a different cell of the cellular telecommunications network, as is required by claim 1.

The existence of more than one cell and a network device within each cell is a significant limitation in claim 1, because the goal of the invention is to select a network device which is close to the user, and the cell the user is located in is what is used in the preferred embodiment at least as a coarse filter to determine what is close. Likewise, the application of selection rules for

this purpose is a significant part of claim 1. The examiner acknowledges in the middle of page 3 of the Office action that these features are not taught in Wang et al. For these features, he relies on Mohebbi et al.

Mohebbi teaches a network having different base stations, and the selection of a particular base station to use for communications depending on the signal quality. Applicants do not claim to have invented multiple base station systems or the selection of the best base station amongst plural candidate base stations for carrying on communications with a mobile device. But that concept is completely different from what is disclosed and claimed in the present case. Applying the teaching of Mohebbi to Wang et al might result in Wang et al having plural cells and monitoring the relative strengths of signals between the mobile terminal and each of the different cell base stations and then choosing which base station to use in communicating with the mobile unit. But regardless of which base station is used, the fax from the mobile would still be sent to the fax machine identified by the destination fax number provided from the mobile unit. In Wang et al, the mobile unit chooses the destination fax machine. According to the present invention, the mobile unit does not choose the destination machine, but instead that choice is made by the rules applied by the computer which receives the command from the base station.

The selection made by the present invention is not the selection of a base station to use, as in Mohebbi. The present invention passes a command from the mobile through a base station, and then after that point, i.e., *after* any choice of base stations by Mohebbi, chooses a network device depending on the base station used. There is no suggestion anywhere in either Wang et al or Mohebbi of choosing a destination for the Wang et al fax from the mobile terminal depending on the particular base station used.

Since neither Wang et al nor Mohebbi teach or suggest applying rules at a computer to select a terminal device resident in the same cell as the wireless telecommunications device at the time the process command was generated by the wireless telecommunications device, it is submitted that the subject matter of claim 1 and all of its dependent claims patentably distinguish over the prior art.

The above analysis has essentially been presented to the examiner, and in the Advisory Action mailed March 31, 2006 the examiner responds by pointing out that Mohebbi teaches selection of a base station from amongst plural base stations. But this misses the point. The present invention is not about choosing a base station. It is about choosing a network device. Even assuming the choice of base station feature were implemented in Wang et al, there would still be no choice of network device resident in the cell of the base station to which the mobile was connected at the time it sent the fax. Since the central concept of the claimed invention is completely absent from either of Wang et al or Mohebbi et al, it could not possibly result from any obvious combination of the teachings of those two references.

Respectfully submitted,

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